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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BHUPESH GUPTA

Appeal 2008-2678
Application 09/997,960
Technology Center 2100

Decided: January 26, 2009

Before JAMES D. THOMAS, JOSEPH L. DIXON, and
HOWARD B. BLANKENSHIP, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-25. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Invention

Appellant's invention relates to an apparatus and method of linking sub-folders in a bookmark folder. In one embodiment, a copy of bookmarks stored in a first sub-folder is created and stored in a second sub-folder (Spec. 4:3-11). In another embodiment, all bookmarks stored in the first sub-folder are copied into the second sub-folder (Spec. 4:3-11). All bookmarks originally stored in the second sub-folder are assembled into a first group and the bookmarks copied into the second sub-folder are assembled into a second group in the second sub-folder such that when the second sub-folder is opened only the bookmarks in the second sub-folder are displayed, the bookmarks in the first group being highlighted to distinguish the bookmarks in the first group from the bookmarks in the second group (Spec. 13:5-11; 19:17-26; 21:5-11).

Representative Claims

1. A computer implemented method of linking a first sub-folder to a second sub-folder in a bookmark folder comprising the steps of:
creating a copy of bookmarks stored in the first sub-folder; and
storing the copy into the second sub-folder.
25. A computer implemented method of linking a first sub-folder to a second sub-folder in a bookmark folder comprising the steps of:

copying all bookmarks stored in the first sub-folder into the second subfolder; and

assembling all bookmarks originally stored in the second sub-folder into a first group and the bookmarks copied into the second sub-folder into a second group in the second sub-folder such that when the second subfolder is opened only bookmarks are displayed, the bookmarks in the first group being highlighted to distinguish the bookmarks in the first group from the bookmarks in the second group.

Prior Art

The Examiner relies on the following references as evidence of unpatentability.

Khan

U.S. 6,546,393 B1

Apr. 8, 2003

Webopedia.com definition of *highlight*, available at: <http://www.webopedia.com/TERM/H/highlight.html> (Sept. 1, 1996) (hereinafter “Web Definition of Highlight”).

Microsoft, *About Microsoft FrontPage* screen shots 1-7 (Dec. 31, 1999) (hereinafter “FrontPage”).

Examiner's Rejections

Claims 1-24 stand rejected under 35 U.S.C. §103 as being unpatentable over FrontPage and Khan. Claim 25 stands rejected under 35 U.S.C. §103 as being unpatentable over FrontPage, Khan, and Web Definition of Highlight.

Claim Groupings

Based on Appellant's arguments in the Appeal Brief, we will decide the appeal on the basis of claims 1 and 25. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUES

(1) Has Appellant shown that the Examiner erred in finding that the combination of FrontPage and Khan teaches creating a copy of bookmarks stored in the first sub-folder and storing the copy into a second sub-folder as recited in claim 1?

(2) Has Appellant shown that the Examiner erred in finding that the combination of FrontPage, Khan and web definition teaches that when the second sub-folder is opened only bookmarks are displayed as recited in claim 25?

FINDINGS OF FACT

1. A bookmark allows a user to store Web addresses or Uniform Resource Locators (URLs) of Web pages, that are to be later re-visited, into a folder (Spec. 2:19-24).

2. FrontPage shows sub-folder 1 that stores a link to “new_page_2.htm” (Page 2).

3. FrontPage shows sub-folder 2 that stores links to “reqdtoc.htm” and “status.htm” (Page 2).

4. The link in sub-folder 1 can be copied and stored in sub-folder 2 (Pages 3-4).

5. When sub-folder 2 is opened, the links from sub-folders 1 and 2 are displayed (Pages 6-7).

6. The link in sub-folder 2 that was copied from sub-folder 1 is distinguished from the original links in sub-folder 2 by the sub-folder 1 heading (Pages 6-7).

7. FrontPage does not explicitly use the term “bookmarks” to describe the links in sub-folders 1 and 2 (Ans. 3).
8. Khan teaches that a bookmark is a saved link to a Web site that, when selected, accesses the linked Web site (col. 14, ll. 44-48; Fig. 6, 610, 612).
9. Web Definition of Highlight teaches that highlighting makes an object on a display screen stand out by displaying it in a different mode from other objects.
10. Displaying a bookmark in a highlighted fashion encompasses any manner of distinguishing the bookmark from other bookmarks (Spec. 22:13-16).
11. One way of distinguishing copied bookmarks from original bookmarks is to place the copied bookmarks under a title (Spec. 19:17-26).

PRINCIPLES OF LAW

Claim Interpretation

During examination, claims are to be given their broadest reasonable interpretation consistent with the specification, and the language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (citations omitted). The Office must apply the broadest reasonable meaning to the claim language, taking into account any definitions presented in the specification. *Id.* (citing *In re Bass*, 314 F.3d 575, 577 (Fed. Cir. 2002)).

Obviousness

The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966).

ANALYSIS

I. Section 103 rejection of claims 1-24

Appellant contends that copying a first sub-folder into a second sub-folder is not the same as creating a copy of bookmarks stored in the first sub-folder and storing the copy into the second sub-folder. Appellant illustrates this contention by stating that FrontPage displays the original content of the second sub-folder and the first sub-folder, and in contrast, the claimed invention displays both the original bookmarks of the second sub-folder and the copied bookmarks (Br. 5). However, displaying both the original bookmarks of the second sub-folder and the copied bookmarks is not recited in claim 1 and there is no basis for reading this element into claim 1.

Appellant further contends that FrontPage does not teach the steps of creating a copy of bookmarks stored in a first sub-folder and storing the copy in a second sub-folder (Br. 5). This contention does not respond to the rejection that the Examiner made. The Examiner found that FrontPage creates a copy of links stored in a first sub-folder and stores the copy in a second sub-folder (Ans. 3). The Examiner further found that a person of ordinary skill in the art at the time of invention would have recognized, after

reading Khan, that the links are bookmarks (Ans. 3-4). We agree with the Examiner's findings (FF 2-8).

Appellant has not provided any response to this prima facie case made by the Examiner. In fact, Appellant has not said anything about the Khan reference, or the combination of FrontPage and Khan, other than "[s]ince the Microsoft FrontPage Screen Shots reference is used in combination with Khan to reject the claims, Applicants [sic] submit that the claims are allowable" (Br. 5).

Furthermore, Appellant's description of a bookmark (FF 1) is met by the links to .htm files shown by FrontPage (FF 2-3). Creating a copy of bookmarks stored in the first sub-folder is disclosed by FrontPage (FF 4). Storing the copy into the second sub-folder is disclosed by FrontPage (FF 4).

Therefore, Appellant has failed to rebut the Examiner's prima facie case for obviousness of the subject matter of claim 1 over FrontPage and Khan. We sustain the rejection of claim 1. Claims 2-24 fall with claim 1.

II. Section 103 rejection of claim 25

Appellant contends that the Examiner did not assert that any of the references teaches the limitations that only bookmarks are displayed when the second sub-folder is opened (Br 6).

Claim 25 recites "when the second sub-folder is opened only bookmarks are displayed, the bookmarks in the first group being highlighted to distinguish the bookmarks in the first group from the bookmarks in the second group."

The Examiner found that FrontPage, on pages 6 and 7, shows that when the second sub-folder is opened only bookmarks are displayed, the

bookmarks in the first group being delineated from the bookmarks in the second group by the “sub-folder 1” heading (Ans. 9-10). The Examiner further found that a person of ordinary skill in the art at the time of invention would have distinguished the bookmarks in the first group by highlighting them instead of placing them under the “sub-folder 1” heading for the benefit of visually differentiating the first and second groups of bookmarks as suggested by the Web Definition of Highlight (Ans. 9).

Appellant’s assertion that “it is clear from page 7 of the Microsoft FrontPage Screen Shots reference that the first sub-folder is also displayed when the second sub-folder is opened” (Br. 6) does not respond to the Examiner’s finding that the sub-folder 1 heading is displayed to distinguish the bookmarks in the first group from the bookmarks in the second group, nor does it respond to the Examiner’s finding that distinguishing the two groups of bookmarks by using highlighting instead of a sub-folder heading would have been obvious.

Furthermore, Appellant’s description of a bookmark (FF 1) is met by the links to .htm files shown by FrontPage (FF 2-3). The term “bookmarks in the first group being highlighted” is broad enough to include placing the bookmarks in the first group under a title, such as sub-folder 1, to distinguish the bookmarks in the first group from the bookmarks in the second group (FF 10-11). Appellant’s examples of highlighting a bookmark (FF 10-11) is met by the copied bookmark placed under a title as shown by FrontPage (FF 6). Therefore FrontPage teaches “when the second sub-folder is opened only bookmarks are displayed, the bookmarks in the first group being highlighted to distinguish the bookmarks in the first group from the bookmarks in the second group” as recited in claim 25.

Appellant has failed to rebut the Examiner's prima facie case for obviousness of the subject matter of claim 25 over FrontPage, Khan and Web Definition of Highlight. We thus sustain the rejection of claim 25.

CONCLUSIONS OF LAW

(1) Appellant has not shown that the Examiner erred in finding that the combination of FrontPage and Khan teaches creating a copy of bookmarks stored in the first sub-folder and storing the copy into a second sub-folder as recited in claim 1.

(2) Appellant has not shown that the Examiner erred in finding that the combination of FrontPage, Khan and Web Definition of Highlight teaches that when the second sub-folder is opened only bookmarks are displayed as recited in claim 25.

DECISION

The Examiner's § 103 rejection of claims 1-24 over FrontPage and Khan is affirmed. The Examiner's § 103 rejection of claim 25 over FrontPage, Khan and web definition is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

msc

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